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EXAMINER

GODENSCHWAGER, PETER F

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

Applicant's arguments filed November 7, 2008 have been fully considered but they are not persuasive.

Applicant's arguments directed towards the claim amendments filed November 7, 2008 are moot as the amendment has not been entered.

Applicant argues that the comparison of E3-2 with E3-3 in the Declaration filed April 25, 2008 shows that superior compactness is achieved by impregnating the dried calcium silicate carrier of the instant claims with an oxidizable composition that is homogeneously dissolved. However, it is not clear from the comparison of E3-2 with E3-3 that the total volume of material is the same for each experiment, nor how long each sample was allowed to sit which would have an effect on the settling of the material, affecting its apparent compactness. It is furthermore not clear what *structural* changes are imparted by the claimed product-by-product limitations. In addition, the scope of independent claim 1, specifically the make-up of the oxidizable organic composition, is much broader than the experiments shown in the Declaration or Example 1 of the instant specification.

Applicant argues that superior compactness is not achieved by treating each of the silica gel carriers of US Pat. No. 5,128,060 with a calcium silicate carrier before granulating, as shown from both E3-1 and E3-2. However, E3-1 does not appear to be showing the treatment of silica gel carriers with calcium silicate carriers before granulating, but treating each of the carriers separately with the easily oxidizable composition. Again, it is not clear from the comparison of E3-1, E3-2, and E3-3 that the total volume of material is the same for each experiment, nor how long each sample was allowed to sit which would have an effect on the settling of the material,

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affecting its apparent compactness. It is furthermore not clear what *structural* changes are imparted by the claimed product-by-product limitations. In addition, the scope of independent claim 1, specifically the make-up of the oxidizable organic composition, is much broader than the experiments shown in the Declaration or Example 1 of the instant specification.

Applicant argues that from both E2-1 and E3-1, superior compactness is not achieved by treating a carrier with an oxidizable composition which is not homogeneously dissolved. However, as set forth above, it is not clear that the total volume of material is the same for each experiment, nor how long each sample was allowed to sit which would have an effect on the settling of the material, affecting its apparent compactness. It is furthermore not clear what *structural* changes are imparted by the claimed product-by-product limitations. In addition, the scope of independent claim 1, specifically the make-up of the oxidizable organic composition, is much broader than the experiments shown in the Declaration or Example 1 of the instant specification.

Applicant argues that the Declaration need not provide illustrations for each and every species within the claims. However, the showing must be commensurate in scope with the claims (See MPEP 716.02(b) III). While a sampling of species may show a general trend, a single data point cannot be representative of a range of claimed variables.

With regards to Applicant's arguments concerning Sugihara et al., one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Applicant argues that the product-by-process steps recited in the instant claims provide a product with unexpectedly better characteristics such as superior compactness. However, as set forth above, specifically with regards to the examples of the Declaration filed April 25, 2008, it is not clear that the total volume of material is the same for each experiment, nor how long each sample was allowed to sit which would have an effect on the settling of the material, affecting its apparent compactness. It is furthermore not clear what *structural* changes are imparted by the claimed product-by-product limitations. In addition, the scope of independent claim 1, specifically the make-up of the oxidizable organic composition, is much broader than the experiments shown in the Declaration or Example 1 of the instant specification.

Applicant argues that the structure is defined in the claims as the carrier is a dried carrier. However, while the term “dried” implies that less liquid/water is present in the composition than initially was there, it does not imply a completely dry composition. A compound which is subjected to a drying step may have a significant amount of water associated with it even after such a step. Therefore, neither carrier that is completely dry, nor any specific degree of dryness can be assumed from the limitations of the claims.

Applicant argues that while Ueno et al. (US Pat. No. 5,128,060) teaches that silica gel having no micropores is more preferable to silica gel containing micropores. However, a reference must be considered for all that it discloses and must not be limited to preferred embodiments (see MPEP 2123). Therefore the broad teaching of Mizutani et al. (US Pat. No. 4,226,636) that the calcium silicate exhibits superior effects to silica when used as an absorbent carrier (7:62-65, 8:1-10) would be enough to motivate one of ordinary skill in the art to replace the silica of Ueno et al. with the calcium silicate of Mizutani et al.

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Applicant argues that claims 3 and 4, reciting a binder, have not been rejected over the combined teachings of Ueno et al. and Mizutani et al. However, claims 3 and 4 have been rejected over Sugihara et al. (US Pat. No. 5,102,673 in view of Mizutani et al. (US Pat. No. 4,226,636) on Pgs. 6-8 of the Office Action mailed August 7, 2008.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER F. GODENSCHWAGER whose telephone number is (571)270-3302. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Supervisory Patent Examiner, Art Unit 1796

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November 14, 2008